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| 10/684,354  | 10/10/2003  | Naoto Moriyama         | 03613/LH            | 3306             |
| 1933 7590 02/03/2009<br>FRISHAUF, HOLTZ, GOODMAN & CHICK, PC<br>220 Fifth Avenue<br>16TH Floor<br>NEW YORK, NY 10001-7708 |             |                        |                     |                  |
| EXAMINER<br>RAJ, RAJIV J  |             |                        |                     |                  |
| ART UNIT<br>3686  |             | PAPER NUMBER           |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/684,354

**Applicant(s)**

MORIYAMA ET AL.

**Examiner**

RAJIV J. RAJ

**Art Unit**

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-9 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-9 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 05 November 2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the amendment filed on 05 November 2008.
2. Claims 2-4, 10-18 & 20-28 have been canceled.
3. Claims 1 & 19 are amended.
4. Claims 1, 5-9 & 19 are currently pending and have been examined.

### **Priority**

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### **Information Disclosure Statement**

6. The Information Disclosure Statement filed 05 November 2008 has been considered. An initialed copy of the Form 1449 are enclosed herewith.

### **Claim Objections**

7. Claims 1 & 19 have been amended and thus the previous objection is withdrawn.

**Claim Rejections - 35 USC § 101**

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 19 is rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). The process steps in claims (19) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.

**Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1, 6-7, 9 & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over lida (US 2003/0020813 A1) (hereinafter lida) in view of Segal et al. (US 2001/0041991 A1) (hereinafter Segal) in further view of Olson et al. (US 2001/0053946 A1) (hereinafter Olson).

13. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

#### **Claim 1**

lida as shown discloses the following limitations:

- *displays the obtained photographing order information;* (see at least lida [0026] Fig:1B Items:14,62 & related text)
- *wherein the control unit sets a transmission-completion flag to the stored photographing order information transmitted to the first portable terminal;* (see at least lida [0121])

lida does not disclose the following limitations, however Segal, as shown does:

- *a control apparatus which controls a generating operation of medical images; (see at least Segal [0021])*
- *a first portable terminal connected to the control apparatus and which obtains photographing order information from the control apparatus; (see at least Segal Fig:1 Items:99-134 & related text)*
- *a medical image generating apparatus which generates medical image data of the patient; (see at least Segal [0021])*
- *wherein the first portable terminal transmits registering information of the medical image corresponding to the obtained photographing order information to the control apparatus; (see at least Segal [0072] Claims:36-38)*
- *(i) a photographing order information storage which stores the photographing order information; (see at least Segal [0021], [0036-0039])*
- *(ii) an interface which transmits the stored photographing order information to the first portable terminal and receives the registering information from the first portable terminal; (see at least Segal [0021], [0075] Fig:1 Items:99-134 & related text)*
- *(iii) a registering information storage which stores the received registering information of the medical image; (see at least Segal Claims:36-38)*
- *(iv) a control unit which corresponds the medical image data transmitted from the medical image generating apparatus with the photographing*

*order information according to the registering information of the medical image; (see at least Segal [0021] Fig:1 Items:99-134 & related text)*

It would have been obvious to one of ordinary skill in the art to add the features of Segal into lida. One of ordinary skill in the art would have added these features into lida with the motivation to provide a more effective and efficient process for creating, storing, accessing, updating and distributing image data. (see at least Segal [0021]) lida and Segal do not disclose the following limitation, however Olson, as shown does:

- *wherein the control unit prohibits the interface from further transmitting the photographing order information when the transmission-completion flag is set to the stored photographing order information; (see at least Olson [0045-0048] Fig:3A Items:200-217, Fig:3B Items:218-234 & related text)*

It would have been obvious to one of ordinary skill in the art to add the feature of Olson into lida/Segal. One of ordinary skill in the art would have added this feature into lida/Segal with the motivation to provide an improved invention for adequately addressing each piece of marked or flagged in an appropriate sequence. (see at least Olson [0012-0015])

#### **Claim 6**

The combination of lida/Segal/Olson disclose all the limitations of Claim 1. lida further discloses the following limitation:

- *further comprising a second portable terminal; (see at least lida Fig:1B Items:14, 60-80 & related text)*

lida/Segal/Olson do not disclose the following limitation, however Olson, as shown does:

- *wherein the information management apparatus stores identification-information of a the first portable terminal for reading out the photographing order information, so as to correspond to the read out photographing order information; (see at least Olson [0045-0048] Fig:3A Items:200-217, Fig:3B Items:218-234 & related text)*

It would have been obvious to one of ordinary skill in the art to add the feature of Olson into lida/Segal/Olson. One of ordinary skill in the art would have added this feature into lida/Segal/Olson with the motivation to provide an improved invention for adequately addressing each piece of marked or flagged in an appropriate sequence. (see at least Olson [0012-0015])

#### **Claim 7**

The combination of lida/Segal/Olson disclose all the limitations of Claim 1. Olson further discloses the following limitation:

- *further comprising an additional control apparatus, wherein the transmission-competition photographing order information is prohibited from being transmitted from the additional control apparatus to the first*



*portable terminal*; (see at least Olson [0045-0048] Fig:3A Items:200-217, Fig:3B Items:218-234 & related text)

It would have been obvious to one of ordinary skill in the art to add the feature of Olson into lida/Segal/Olson. One of ordinary skill in the art would have added this feature into lida/Segal/Olson with the motivation to provide an improved invention for adequately addressing each piece of marked or flagged in an appropriate sequence. (see at least Olson [0012-0015])

#### **Claim 9**

The combination of lida/Segal/Olson disclose all the limitations of Claim 6. lida further discloses the following limitations:

- *further comprising an additional control apparatus*; (see at least lida Fig:1B Items:14, 60-80 & related text)
- *wherein after the photographing order information is transmitted from one of the control apparatuses to any one of the portable terminals, another one of the control apparatuses deletes the photographing order information*; (see at least lida [0025] & [0063])

#### **Claim 19**

lida as shown discloses the following limitation:

- *setting a transmission-completion flag to the stored photographing order information transmitted to the portable terminal via the control unit*; (see at least lida [0121])

lida does not disclose the following limitations, however Segal, as shown does:

- *storing photographing order information in a photographing order information storage of a control apparatus; (see at least Segal [0021], [0036-0039])*
- *transmitting the stored photographing order information to a portable terminal via an interface of the control apparatus; (see at least Segal [0021], [0075] Claims:36-38 Fig:1 Items:99-134 & related text)*
- *receiving registering information of the medical image for the transmitted photographing order information from the portable terminal via the interface; (see at least Segal Claims:36-38)*
- *storing the received registering information of the medical image in a registering information storage of the control apparatus; (see at least Segal [0036-0038])*
- *corresponding the medical image data generated by a medical image generating apparatus with the photographing order information according to the registering information of the medical image via a control unit of the control apparatus; (see at least Segal [0021] Fig:1 Items:99-134 & related text)*

It would have been obvious to one of ordinary skill in the art to add the features of Segal into lida. One of ordinary skill in the art would have added these features into

lida with the motivation to provide a more effective and efficient process for creating, storing, accessing, updating and distributing image data. (see at least Segal [0021]) lida and Segal do not disclose the following limitation, however Olson, as shown does:

- *prohibiting, via the control unit, further transmission of the photographing order information when the transmission completion flag is set to the photographing order information;* (see at least Olson [0045-0048] Fig:3A Items:200-217, Fig:3B Items:218-234 & related text)

It would have been obvious to one of ordinary skill in the art to add the feature of Olson into lida/Segal. One of ordinary skill in the art would have added this feature into lida/Segal with the motivation to provide an improved invention for adequately addressing each piece of marked or flagged in an appropriate sequence. (see at least Olson [0012-0015])

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over lida in view of Segal in view of Olson in further view Jordan (US 2002/0188187 A1) (hereinafter Jordan).

#### **Claim 5**

The combination of lida/Segal/Olson disclose all the limitations of Claim 1. lida further discloses the following limitations:

- *further comprising a second portable terminal; (see at least lida Fig:1B Items:14, 66-80 & related text)*
- *when the transmission-completion flag is set to the photographing order information and then a command for reading out the photographing order information is output from the second portable terminal, the second portable terminal is notified that the photographing order information has been already read out based on the stored information; (see at least lida [0121])*

lida/Segal/Olson do not disclose the following limitation, however Jordan, as shown does:

- *wherein the information management apparatus stores identification-information of the first portable terminal for reading out the photographing order information, so as to correspond to the read out photographing order information; (see at least Jordan [0035-0036])*

It would have been obvious to one of ordinary skill in the art to add the feature of Jordan

into lida/Segal/Olson. One of ordinary skill in the art would have added this feature into lida/Segal/Olson with the motivation to provide a more safe & efficient process for managing and transferring medical image data. (see at least Jordan [0006])

15. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over lida in view of Segal in view of Olson in further view Endo et al. (US 4567897) (hereinafter Endo).

**Claim 8**

The combination of lida/Segal/Olson disclose all the limitations of Claim 6. Endo further discloses the following limitation:

- *wherein when the control apparatus is instructed so that the photographing order information transmitted to any one of the portable terminals is transmitted to any one of the portable terminals again, the control apparatus warns that the photographing order information has been already transmitted; (see at least Endo Column:5 Lines 60-69 Column:4 Lines:1-22)*

It would have been obvious to one of ordinary skill in the art to add the feature of Endo into lida/Segal/Olson. One of ordinary skill in the art would have added this feature into lida/Segal/Olson with the motivation to provide a more effective and efficient method and system for storing and transmitting medical image data. (see at least Endo Column:2 Lines: 54-63)

**Response to Arguments**

16. Applicant's arguments filed 05 November 2008 have been fully considered but they are not persuasive.

17. Applicant's arguments with respect to claims 1, 5-9 & 19 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJIV J. RAJ whose telephone number is (571) 270-3930. The examiner can normally be reached on Monday thru Friday 8-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

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01/26/09

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